UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,101	07/25/2005	Hirobumi Toyoda	ARF-084US	9108

21254 7590 05/03/2007

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER	
THOMASSON, MEAGAN J	
ART UNIT	**PAPER NUMBER**
3714	

MAIL DATE	DELIVERY MODE
05/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/528,101	TOYODA, HIROBUMI	
	Examiner	Art Unit	
	Meagan Thomasson	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 March 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/16/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The examiner acknowledges the amendments made to claims 2-4, as well as the addition of claims 8-10.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed on March 16, 2005.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, claim 7 recites "A program for a gaming machine". A program is considered non-statutory subject matter (MPEP § 2106), and the examiner suggests changing the claim to "a computer implemented-readable medium encoded with a computer program".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1,2,8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US 6,824,463 B1).

Regarding claim 1, Yamaguchi discloses a lottery board provided with a plurality of lottery holes and a face portion on which a lottery ball can roll (abstract, Fig. 1) and game result determination means for determining a game result on a basis of identification information associated with any one of the plurality of lottery holes receiving the lottery ball under a condition that the lottery ball enters said any one of the plurality of lottery holes (col. 5, lines 54-57), each of the plurality of lottery holes of said lottery board being associated with identification information for determining a lottery result (abstract). *Yamaguchi does not specifically disclose the use of a plurality of lottery boards.* However, the addition of another lottery board is mere duplication of parts, as it does produce a new and unexpected result in the game, and thus would have been obvious to one of ordinary skill in the art at the time of the invention (see In re Harza, 274 F.2d 669, 124 USPQ 378).

Regarding claim 2,9 Yamaguchi discloses that the game result determination means comprises identification information selecting means for selecting the identification information being composed of a plurality of symbol codes, each of which is in association with the lottery hole receiving the lottery ball under a condition that the lottery ball enters said any one of the plurality of lottery holes (col. 5, lines 54-57), and game control means for determining the game result on a basis of the identification information selected by the information selecting means (Fig. 6; col. 4, lines 20-29), wherein the plurality of lottery holes of the lottery board are allocated with respective symbol codes that constitute the identification process (abstract, lines 7-8).

Regarding claim 8, in addition to the gaming machine as described above, Yamaguchi discloses a slope for guiding lottery balls (Fig. 3).

Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US 6,824,463 B1) in view of Morsch (US 2,668,716).

Regarding claims 3 and 10, Yamaguchi discloses a gaming machine as described above. *Yamaguchi does not specifically disclose a cabinet having the plurality of lottery boards, and tilting control means for tilting the cabinet, wherein the lottery ball rolls over the plurality of lottery boards as the cabinet is tilted by the tilting control means.* However, Morsch discloses a rolling ball game device featuring said tilting control means for tilting the cabinet (col. 1, line 56-col. 2, line 15), wherein in this instance the cabinet comprises the post 12 and bowl 10 of Figs. 1-3. The use of the tilting mechanism allows for the creation of "unusual and intriguing motions... so as to be attractive to the players or users" (col. 1, lines 1-6). Similary, the invention disclosed

by Yamaguchi discloses means for creating unusual and intriguing ball movement patterns, such as increasing or decreasing the speed of rotation of the lottery board, or changing the direction of rotation of the lottery board (col. 5, lines 60-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a tilting mechanism in the invention disclosed by Yamaguchi in order to create an additional means for altering the course of the ball. Additionally, the inventions disclosed by Yamaguchi and Morsh are analogous in that they are both chance devices featuring a rotating lottery board provided with a plurality of lottery holes and a face portion on which a lottery ball can roll.

Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US 6,824,463 B1) in view of Sher (US 5,755,440).

Yamaguchi discloses a lottery board having a face portion, on which a lottery ball rolls, and a plurality of lottery holes on the face portion, game result determination means for determining a game result on a basis of any one of the plurality of lottery holes, which the lottery ball is to enter, rotation control means for controlling the lottery board such that the lottery board is rotated clockwise or counter-clockwise (col. 5, lines 60-65), lottery ball throwing means for releasing a lottery ball onto the lottery board face portion, as well as lottery ball throwing control means (Fig. 3). *Yamaguchi does not specifically disclose first and second lottery ball throwing means, lottery ball detecting means for detecting whether the lottery ball is thrown from either the first lottery ball throwing means or the second lottery ball throwing means, wherein the rotation control means has a function to determine the rotational direction of the lottery board on a basis*

of a detection result of the lottery ball detecting means. However, Yamaguchi discloses a rotational control mechanism that "dynamically changes the ...rotational direction" of the rotating unit (col. 5, lines 61-62), as well as a supply-mechanism control unit for controlling the release of the balls (col. 5, lines 48-51). In an analogous invention, Sher discloses first and second ball throwing means for launching two balls onto the lottery board (col. 4, line 58 – col. 5, line 52), capable of launching the balls in any direction. Therefore, the combined teachings of Yamaguchi and Sher are capable of detecting the direction of launch of the balls, and adjusting the rotational direction of the lottery board in accordance with said direction. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Yamaguchi and Sher, as they are analogous inventions in the same field of endeavor.

Regarding claim 7, specifically the limitation that the gaming machine is operating by means of executing a program, the gaming machine of Yamaguchi is disclosed as being operated by a controller (col. 4, line 10). As is well known in the art, a controller contains a program for executing commands.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pertinent prior art includes Uchiyama et al. (US 2006/0012117 A1), drawn to a bingo game machine featuring a rotating lottery board, Chee (US 6,164,647), drawn to a casino wheel game system, Matsumoto et al. (US 5,639,089), drawn to a bingo game machine having a rotatable roulette unit which catches balls,

Kaneko et al. (US 5,879,235), drawn to a ball game machine with a roulette-type rotary disk, Sokolov (US 2005/0167912 A1), drawn to a roulette-type gaming system, Luciano et al. (US 6,561,512 B2 and US 7,021,624 B2), both drawn to gaming device with spinning wheels, and Uehara et al. (US 6,164,646), drawn to a ball game machine.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert E Pezzuto
Supervisory Patent Examiner
Art Unit 3714

Meagan Thomasson
April 30, 2007